

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicant: Jack J. Johnson and William F. Coyle

Serial No.: 10/062,798

Filed: 01/31/2002

For: Bidding for Energy Supply

Examiner: Weisberger, Richard C.

Art Unit: 3693

**REQUEST FOR REFUND**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

We received and reviewed our February Monthly Statement of Deposit Account and are requesting a refund in the amount of \$120.00 for the above-referenced application. A copy of the deposit account statement is attached hereto at Exhibit A. According to the fee code (1251) noted on the statement, we were charged \$120.00 for a one month extension of time.

An Information Requirement under 37 CFR 1.105 was mailed on November 14, 2006, wherein a two month time period for a response was noted therein. Attached hereto at Exhibit B is a copy of the Information Requirement. Attorney for Application filed a response to the Information Requirement on January 16, 2007. Attached hereto at Exhibit C is a copy of the response. Because the two month due date fell on Sunday, January 14, 2007, and the U.S. Patent and Trademark Office was closed on Monday, January 15, 2007, the federal holiday for Martin Luther King Day, the time period for responding extended to January 16, 2007. Accordingly, a response was timely filed and no extension was necessary.


MEI 6272141v.1

Serial No. 10/062,798  
March 28, 2007  
Page 2

Accordingly, it is hereby requested that Deposit Account No. 503571 be credited \$120.00.

Dated: 3/30/07

Respectfully submitted,

  
Michael R. Friscia  
Reg. No. 33,884  
McCarter & English, LLP  
Four Gateway Center  
100 Mulberry Street  
Newark, NJ 07102  
Tel.: (973) 639-8493  
Fax: (973) 297-6627

MEI 6272141v.1

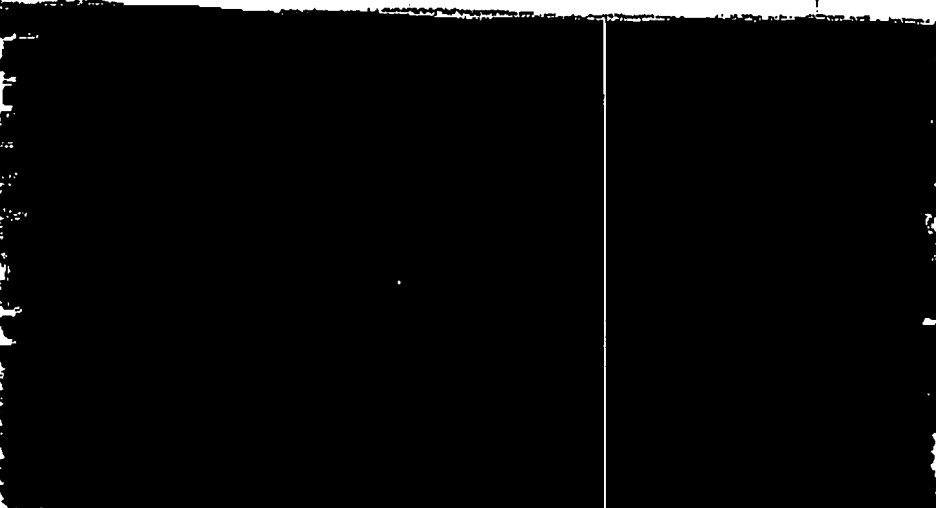
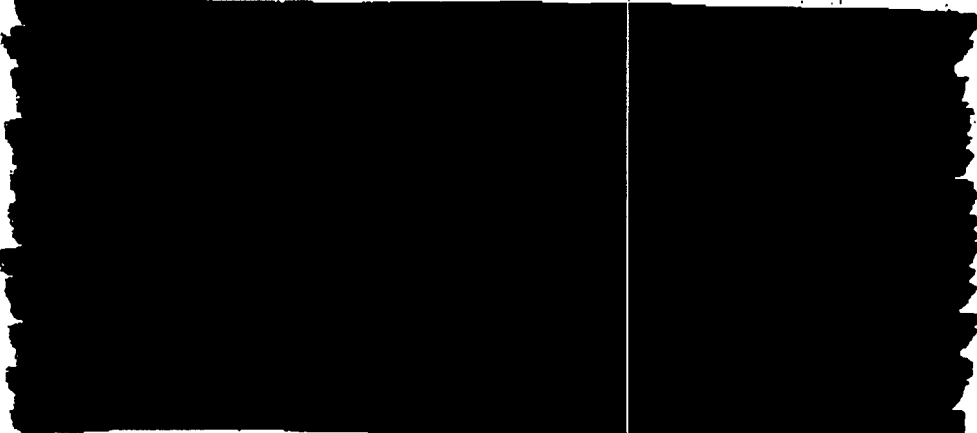
# EXHIBIT A

**United States  
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Trademark Office**

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**Deposit Account Statement**

Requested Statement Month: February 2007  
Deposit Account Number: 503571  
Name: MCCARTER & ENGLISH, LLP  
Attention: MARY MCDONALD  
Address: FOUR GATEWAY CENTER  
City: NEWARK  
State: NJ  
Zip: 07102  
Country: UNITED STATES

DATE SEQ	POSTING REF TXT	ATTORNEY DOCKET NBR	FEE CODE	AMT	BAL
					
02/12 2	10062798	33472/1	1251	\$120.00	\$41,425.00
					

# EXHIBIT B

MAR. 30. 2007 1:40PM

MCCARTER&amp;ENGLISH

NO. 0647 P. 8



## UNITED STATES PATENT AND TRADEMARK OFFICE

STEVE

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www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/062,798	01/31/2002	Jack J. Johnson	33472/1	3434
27614	7590	11/14/2006		
MCCARTER & ENGLISH, LLP FOUR GATEWAY CENTER 100 MULBERRY STREET NEWARK, NJ 07102				
EXAMINER WEISBERGER, RICHARD C				
ART UNIT		PAPER NUMBER		
3693				

DATE MAILED: 11/14/2006



Please find below and/or attached an Office communication concerning this application or proceeding.

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NO. 0647 P. 9



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Alexandria, Virginia 22313-1450

APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
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10-062-798

EXAMINER
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ART UNIT	PAPER
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20061112

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

Richard C Weisberger  
Primary Examiner  
Art Unit: 3693

Application/Control Number: 10/062,798

Page 2

Art Unit: 3693

Applicant and the assignee of this application are required under 37 CFR 1.105 to provide the following information that the examiner has determined is reasonably necessary to the examination of this application.

In response to this requirement, please provide answers to each of the following interrogatories eliciting factual information:

In response to this requirement, please provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of the energy auction system described of the specifications.

In response to this requirement, please provide the names of any products or services that have incorporated the claimed subject matter.

In response to this requirement, please provide the names of any products or services that have incorporated the claimed invention.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

The applicant is reminded that the reply to this requirement must be made with candor and good faith under 37 CFR 1.56. Where the applicant does not have or cannot readily obtain an item of required information, a statement that the item is unknown or cannot be readily obtained may be accepted as a complete reply to the requirement for that item.



Application/Control Number: 10/062,798

Page 3

Art Unit: 3693

This requirement is subject to the provisions of 37 CFR 1.134, 1.135 and 1.136 and has a shortened statutory period of two months. EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136(a).

Respectfully



Rich Weisberger

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James Trammel

# EXHIBIT C

Attorney Reference No.: 33472/1

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of  
JOHNSON, Jack J. et al.

Serial No. 10/062,798

Confirmation No.: 3434

Filed: January 31, 2002

For: BIDDING FOR  
ENERGY SUPPLY

Group Art Unit: 3693

Examiner: WEISBERGER, Richard C.

I hereby certify that this correspondence and/or fee is  
being deposited with the United States Postal Service as  
First Class Mail in an envelope with sufficient postage  
addressed to Mail Stop Amendment, Commissioner for  
Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on

January 16, 2007  
*Steve E. Papp* 1/16/2007  
(Signature) (Date)

Mail Stop Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO REQUIREMENT FOR INFORMATION

Dear Sir:

This is a response to a Rule 1.105 Requirement for Information dated November 14, 2006 (the "Information Requirement") in connection with U.S. Patent Application No. 10/062,798 (the "Application"), the time period for responding to which extends to January 16, 2007.<sup>1</sup> At page 2 of the Information Requirement, the Examiner posed three (3) interrogatories, each of which shall be discussed below.

<sup>1</sup> The Information Requirement sets a two-month time period for response. However, the U.S. Patent and Trademark Office was closed on January 14, 2007 (Sunday) and January 15, 2007 (federal holiday for Martin Luther King Day), resulting in an initial due date of Tuesday, January 16, 2007.

Application No. 10/062,798

Written Reply dated January 16, 2007

Responsive to Information Requirement mailed November 14, 2006

### REMARKS

First, the Examiner has requested that Applicants "provide copies of each publication which any of the applicants authored or co-authored and which describe the disclosed subject matter of the energy auction system described of the specifications."

In response to the first interrogatory, the undersigned has been informed that Applicants have neither authored nor co-authored any *conventional* publications describing the subject-matter of the energy auction system described in the specifications, e.g., journal or magazine articles, books, etc. However, Applicants note the following in regard to other writings that might be considered "publications" under a broad reading of the Examiner's first interrogatory:

Applicants assisted with the preparation (authoring) of the Application and those other patent applications sharing the priority chain of the Application. Such patent applications and two patents issuing therefrom to date have been published (or made publicly available) by the USPTO. Applicants also participated in the preparation of PCT Application No. PCT/US98/02910 published by WIPO on September 11, 1998, and PCT Application No. PCT/US01/08639 published by WIPO on October 11, 2001.

The public utility commissions ("PUCs") in the states of New Jersey, Ohio and Illinois have each conducted public proceedings in the course of authorizing electric power auctions in their respective states. Applicants have communicated by letter with each of these PUCs to make them aware of Applicants' issued patents and pending patent applications (including the present Application) regarding certain energy auction systems. These letters may have become part of the public record of such PUC proceedings. After reviewing these

Application No. 10/062,798

Written Reply dated January 16, 2007

Responsive to Information Requirement mailed November 14, 2006

letters (as well as certain letters sent by Applicants to third parties, copies of which were also furnished by Applicants to such PUCs in the course of their public proceedings), Applicants enclose the following:

- (A) Letter to Frances L. Smith, Secretary of the New Jersey Board of Public Utilities dated November 2, 2001 (three pages).
- (B) Letter to Jeanne M. Fox, President of the New Jersey Board of Public Utilities, dated July 12, 2002, including as an attachment thereto a letter to Irah H. Donner of Hale and Dorr, LLP, counsel to certain electric utility companies in New Jersey, dated April 30, 2002 (eight pages including said attachment).
- (C) Letter to New Jersey Board of Public Utilities dated January 30, 2003 (four pages).
- (D) Letter to New Jersey Board of Public Utilities dated October 17, 2003 (two pages).
- (E) Letter to New Jersey Board of Public Utilities dated January 26, 2004 (three pages).
- (F) Letter to the Public Utilities Commission of Ohio dated November 19, 2004 (three pages).
- (G) Letter to The Illinois Commerce Commission dated August 18, 2006 (three pages).

The Examiner's second and third interrogatories in the Information Requirement respectively request the Applicants to "provide the names of any products or services that have incorporated the claimed subject matter" and "provide the names of any products or services that have incorporated the claimed invention."

Application No. 10/062,798

Written Reply dated January 16, 2007

Responsive to Information Requirement mailed November 14, 2006

Applicants have not introduced into the marketplace any product or service that incorporates the claimed subject matter and/or claimed invention of the present Application. Regarding such products or services introduced by third parties, Applicants believe that certain electric power auctions conducted by electric utility companies in the states of New Jersey, Ohio and Illinois, and authorized by the respective PUCs in such states (as referenced above), may incorporate the claimed subject matter and/or the claimed invention of the present Application. For the Examiner's convenience, more information about each of these electric power auctions can be found at the following website addresses: (i) for the New Jersey Basic Generation Service Auction, see <http://www.bgs-auction.com> and <http://www.bpu.state.nj.us/home/bgs.shtml>; (ii) for the Ohio Competitive Bid Process in late 2004, see <http://dis.puc.state.oh.us/CaseRecord.aspx> (Note: In "case lookup #" box in upper right of webpage, enter the case number "04-1371-EL-ATA" and click "search"); and (iii) for the Illinois Auction in September 2006, see <http://www.illinois-auction.com> and <http://www.lcc.illinois.gov/e-Docket/reports/browse/default.asp> (then enter one or more of the following four docket numbers and select "Go": 05-0159, 05-0160, 05-0161 and 05-0162). Applicants also refer the Examiner to the Petition to Make Special filed in July 2003 with respect to the present Application and which discusses in brief the New Jersey Basic Generation Service Auction.

Application No. 10/062,798

Written Reply dated January 16, 2007

Responsive to Information Requirement mailed November 14, 2006

Applicants have informed the undersigned that they are aware of other governmental and private entities who have authorized, sponsored or conducted energy-related auctions or competitive bidding programs, but Applicants either believe such auctions or bidding programs do not incorporate the claimed subject matter or the claimed invention as disclosed in the present Application or do not know sufficient specific details about such auctions or bidding programs to make a definitive determination to that effect. For example, Applicants are aware of an energy auction service offered by World Energy Exchange, a private company operating a website at [www.worldenergy.com/wee.html](http://www.worldenergy.com/wee.html). Based on the limited information available to the public on the website (as opposed to the specific details made available to registered, pre-screened buyers and sellers), Applicants have not yet been able to evaluate whether World Energy Exchange's auction service "incorporates the claimed subject matter" or "the claimed invention" of the present Application. In this regard, Applicants respectfully submit that Applicants are not required to "derive or independently discover a fact ... in response to a requirement for information."

See M.P.E.P. § 704.11.

Application No. 10/062,798

Written Reply dated January 16, 2007

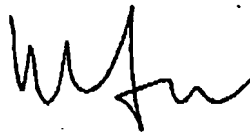
Responsive to Information Requirement mailed November 14, 2006

**CONCLUSION**

Should there remain any questions or other matters whose resolution could be advanced by a telephone call, the Examiner is invited to contact the undersigned attorney at the number below. Although the undersigned believes that no extension of time request and fee is due in connection with this Response, to any extent such petition would be due to consider this Response, the undersigned respectfully requests that this Response be considered as including a petition therefor and the Examiner charge the fee to Deposit Account 503571. The Examiner is authorized to charge any deficiency and/or credit any overpayment to Deposit Account 503571.

Respectfully submitted,

MCCARTER & ENGLISH, LLP



By: Michael R. Friscia  
Reg. No. 33,884

McCarter & English, LLP  
Gateway Center Four  
100 Mulberry Street  
Newark, NJ 07102  
Telephone: (973) 622-4444  
Facsimile: (973) 624-7070



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**FACSIMILE TRANSMISSION**

2007 APR -2 PM 4: 59



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**FAX No:**

(571) 273-6500

**PHONE No:**

**FROM:**

Michael Friscia/03445

**EMAIL:**

MFriscia@mccarter.com

**FAX No:**

973.297.6627

**PHONE No:**

973.639.8493

**March 30, 2007**

Total number of pages including cover: 17

Client/Matter: 33472/00002

Call, if Problems:

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McCarter & English LLP  
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Re: Our file: 33472-00002  
Applicant: Jack J. Johnson and William F. Coyle  
Serial No.: 10/062,798  
Filing Date: 01/31/2002  
Title: Bidding for Energy Supply

Examiner: Weisberger, Richard  
Art Unit: 3693

Sir:

Enclosed for filing in the United States Patent and Trademark Office is the following:

1. Request for Refund with Exhibits A-C
2. Transmittal Sheet


CONDITIONAL PETITION

If any extension of time is required for the submission of the above-identified items, Applicant requests that this be considered a petition therefor. Please charge any additional charges or any other charges relating to this matter, or credit any overpayment, to the Deposit Account of the writer, Account No. 503571. A duplicate copy of this letter is enclosed.

3/30/07  
Date

enc.

Respectfully submitted,

  
Michael R. Friscia  
Registration No. 33,884  
McCarter & English, LLP  
Four Gateway Center  
100 Mulberry Street  
Newark, NJ 07102  
Tel: (973) 639-8493  
Fax: (973) 297-6627

I hereby certify that the following papers are being facsimile transmitted to the U.S. Patent and Trademark Office to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 to telefax no. (571) 273-6500 on 3/30/07.

By:

  
Janelle Fava

ME1 6272249v.1